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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,341	02/10/2004	Yasunobu Tanaka	NDTCO.029A	8511

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EXAMINER

FORD, ALLISON M

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/775,341

Applicant(s)

TANAKA ET AL.

Examiner

Allison M. Ford

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☒ Newly proposed or amended claim(s) 10-13 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 10-13.

Claim(s) objected to: _____.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: 27-64.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s): rejection of claims 10-13 under 35 USC 103(a) over Webb et al (US Patent 6670129), in view of Ausubel et al (Current Protocols in Molecular Biology, 1988).

Continuation of 11. does NOT place the application in condition for allowance because: the arguments were not found persuasive to overcome the rejection of claims 1-8.

In the final rejection the examiner maintained the rejection over Webb et al in view of Ausubel et al, stating that the difference between the instant invention and the prior art is the order of adding ingredients, and that altering the order taught in the prior art would have been prima facie obvious to one of ordinary skill in the art in order to increase the stability of the transfection device, as CaCl₂ is more stable than DNA over long periods of time.

Applicants argue that the cited references fail to teach all of the limitations of the claimed invention and provide no motivation to make the claimed invention.

Specifically with regards to claim 1, and dependents thereof, applicants argue that the amended claim recites the limitation "a transfection agent comprising a metal salt which is not pre-mixed with the biomolecule." Applicants argue that the references, which teach a CaPO₄-DNA coating (transfection agent) is clearly outside the scope of claim 1, as claim 1 defines the transfection agent as the metal salt alone.

Such is not found persuasive because, while amended claim 1 does state the biomolecule cannot be pre-mixed with the metal salt, it does not define the transfection agent as the metal salt alone. Instead the claim only prevents the metal salt and the biomolecule from being pre-mixed, it does not exclude the biomolecule from being added subsequently to the composition, so that the final multiwell plate comprises both the metal salt and a biomolecule; therefore the rejection of record stands, in that the claim still allows for the transfection agent to comprise a metal salt and a biomolecule, and as discussed in the rejection of record, the order of adding the ingredients would have been prima facie obvious.

With regards to claim 10, and dependents thereof, applicants argue that the closed language "consisting essentially of" which precludes the presence of a biomolecules on the cell culture/transfection device. Applicants argue that this relatively closed language requires the calcium chloride salt to be added first, thereby rendering non-obvious the order of adding ingredients. Applicants cite Ex parte Parks et al to support the stand that the order of adding ingredients, when the claim language specifically excludes one or more ingredients from the first 'addition step', the order of adding ingredients is not merely prima facie obvious, but is critical to the invention, and is limited by the claim language.

These arguments pertaining to claim 10 and dependents thereof are found persuasive. The claim language "consisting essentially of a solid surface, wherein the solid surface is coated with calcium chloride in a gel matrix" does exclude the inclusion of biomolecules in the initial transfection agent, and is sufficient to render the order of adding ingredients non-obvious. .

RUTH A. DAVIS
PATENT EXAMINER

